

### Remarks

The present Amendment is being filed within the statutory period for reply, which is scheduled to end on November 10, 2006. Claims 1-21 are currently pending in the present application. By this Amendment, each of claims 1, 3, 8, 13, 15 and 21 have been amended and claims 2, 12, 14 and 19 have been canceled.

The Examiner has indicated that claim 8 would be allowable if rewritten in independent form including all limitations of the base claim and any intervening claims.

Claim 8 has been amended as suggested and is now believed to be in condition for allowance.

### Claim Rejections

The Examiner has rejected each of claims 1-7, 9-17 and 20-21 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,666,864 to Bencini et al. ("Bencini"). The Examiner has further rejected claims 18 and 19 under 35 U.S.C. § 103(a) as being obvious in view of Bencini.

In rendering these rejections, the Examiner has indicated that electrodes (20) of Bencini can be considered active or return absent further structural recitation in the claims of the present application. Applicant has amended independent claims 1, 13, 15 and 21 to recite "an active electrode *electrically coupled to an electrosurgical generator for providing electrosurgical energy thereto*," thereby providing further structural definition as to what constitutes an active electrode. In view of these amendments and for the reasons outlined below, applicant believes that the present independent claims are clearly distinguishable from Bencini.

Bencini discloses a device having slidable, electrically conductive elements 48, through which power is supplied via wires 50. Thus, any given electrode 20 in Bencini can only be an "active electrode" under the amended claims of the present application if it is in electrical contact with element(s) 48 (and thus coupled to the power supply). Accordingly, it follows that Bencini fails to disclose a *separate* "converting element" that moves between a first position wherein it is electrically coupled to an active electrode and a second position where it is not electrically coupled to *the same* active electrode, as recited in the present independent claims. It further follows that Bencini fails to disclose a device that, by moving this separate converting element between the first

and second position, enables one to change the effective surface area of the active electrode relative to the return electrode, as is also currently recited in all independent claims. Finally, the amended claims now clearly recite that bipolar energy can be applied to the active electrode in both the first and second positions of the converting element. As Bencini fails to teach each and every element of these amended claims, it fails to anticipate such claims.

With regard to the rejection of claims 18 and 19, the Examiner has stated that Bencini is silent regarding positions that are suitable for cutting versus coagulation, but that this would be simple optimization obvious to one skilled in the art from the disclosure of Bencini. Applicant respectfully disagrees.

Bencini discloses a device suitable for making lesions by soft tissue *coagulation* in order create a predetermined lesion path that will function to conduct electricity. (See Col. 1, lines 44-67). The device of Bencini would be entirely **unsuitable** for its intended purpose if it reached current densities sufficient for cutting or vaporization of that tissue (i.e. vaporizing endocardium tissue) rather than coagulating it to form lesions. As indicated in the present application, current densities required for cutting or vaporization require a much smaller relative surface area of the active electrode as compared to the return electrode in order to obtain the very high current density needed at the active electrode for vaporization. There is no such teaching in Bencini, let alone any teaching of a device, or the desire to have a device, that has both capabilities. Given the lack of express teaching in Bencini as to having cutting and coagulation capabilities in a single instrument, the lack of any suggestion or desire to do so set forth in the reference, and the fact that a vaporization capability in the device of Bencini would be unsuitable for its intended purpose, applicant respectfully submits that Bencini does not teach or suggest the invention claimed in present claim 18, which for simplicity has been amended to include the limitations of original claim 19.

In view of the foregoing amendments and remarks, applicant believes that each of amended independent claims 1, 13, 15 and 21, and claims 3-7, 9-11, 16-18, and 20 which depend therefrom, are patentable over the cited reference. Reconsideration and allowance is respectfully requested.

Applicants believe that no fee is due in connection with this response. The Commissioner is hereby authorized, however, to charge any additional fees that may

be required to Account No. 10-0750/GYN-5004/MJS. This Authorization is being submitted in triplicate.

Respectfully submitted,

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